UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,187	03/10/2004	Norbert Rick	MERCK-2862	2740

23599 7590 03/07/2008

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

EXAMINER	
MARCHESCHI, MICHAEL A	

ART UNIT	PAPER NUMBER
1793	

MAIL DATE	DELIVERY MODE
03/07/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/796,187	RICK ET AL.	
	Examiner	Art Unit	
	Michael A. Marcheschi	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 13-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 13-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-7 and 13-23 are rejected under 35 U.S.C. 103(a) as being obvious over either (1) Schoen et al. US 2002/0192448 or (2) Schoen et al. (6,884,289) both in view of Andes et al. (2003/0005859) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1-7 and 13-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,884,289 in view of Andes et al. (2003/0005859) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Applicant's arguments filed 1/7/08 have been fully considered but they are not persuasive.

Applicants mischaracterize the rejection in that it was not stated that it would have been obvious to substitute the covering of absorbent particles in Schoen's pigment with the absorbent layer of Andres. However, the rejection in the previous office action clearly established (stated) that the skilled artisan would have appreciated and thus found it obvious to use any known inorganic *pigment* (material) that is an absorbent (secondary reference clearly teach that the claimed material is a known absorbing pigment) as the pigment (material) in the layer (absorbent) according to the Schoen references because the use of any known absorbing pigment is clearly within the level of ordinary skill in the art. In addition, the previous office action

clearly stated the substitution of one known absorbing pigment for the absorbent material defined by the Schoen references is clearly within the level of ordinary skill in the art because they are used for the same purpose (i.e. substitution of one absorbent material for another (that is known for the same purpose) in the absorbent layer of Schoen is obvious). In other words, the examiners rejection clearly stated that the use of a known absorbing material (as is clearly defined by Andres) in the absorbent layer according to Schoen is obvious and not that the substitution of a layer for a pigment is obvious as is characterized and argued by applicants.

In summary, the previous rejection has been mischaracterized by applicants and the remarks against that mischaracterization are noted, however, no further comment on these remarks in necessary because applicants are not arguing the examiners rejection that the use any known inorganic pigment (material) that is an absorbent (as shown by Andres) as the pigment (material) in the layer (absorbent) according to the Schoen references is obvious. Furthermore, applicants response is that the examiner rejection is changing the structure of absorbent layer of Schoen. However, this is not the case, because the structure of absorbent layer in this reference is not being changed only the material used in said layer is being changed and changing a material in said layer will not result in a structural change of the absorbent layer.

Applicants appear to argue that no reason is apparent to select the titanium oxynitride or titanium nitride materials from the long list of possible absorbent materials provided by Andres. The motivation is clearly defined by this reference which specifically names these materials as absorbent oxides (i.e. they are pigment). It is not picking and choosing (which is apparently applicants argument) when the species is clearly named and when the species is clearly named, the selection from a long list does not avoid a 103 rejection (see Ex parte A, 17 USPQ2d 1716

(Bd. Pat. App. & Inter. 1990) (The claimed compound was named in a reference which also disclosed 45 other compounds. The Board held that the comprehensiveness of the listing did not negate the fact that the compound claimed was specifically taught. See also In re Sivaramakrishnan, 673 F.2d 1383, 213 USPQ 441 (CCPA 1982) and MPEP 2131.02). As defined above, clear motivation has been establish to use titanium oxynitride or titanium nitride and applicants provide no evidence of criticality rebutting this.

Applicants continue to argue that, although the Schoen et al. references define the covering (D) of absorbent particles as a layer, this is clearly different from the layer of the claimed invention and thus the covering is discrete pigment particles and not an "absorbent layer" as defined by applicants invention. The examiner is unclear as to applicants argument because (1) column 3, line 35 of Schoen et al. (289) and section [0028] of Schoen et al. (448) literally define "layer D" which made up of absorbent pigment particles, thus these references are clearly defining "layers" and (2) a claim can be given its broadest interpretation and applicants do not distinguish the absorbent layer (D) of the instant claims with the absorbent layer of the references (i.e. reference layers (D) are layers of absorbent particles, thus broadly reading on the claimed absorbent layer). Applicants also state that in these references, the covering is a collection of particles on the surface rather than a contiguous layer. This argument is not understood because this "covering" is clearly defined by the references as a layer and it is contiguous with the preceding layer. Applicants have yet to show clear evidence as to why layer D of the references is not an absorbing layer because the "covering" of the references is a layer (literally defined by the reference -see above) and the layer is an absorbing layer (by use of absorbent pigments in the layer), thus this clearly reads on an absorbent layer absent clear

evidence to the contrary. For a further discussion, applicants are referred to the examiners previous final office action dated 6/27/06 in which the examiner clearly defined reasons why the references teach layers, said remarks being incorporated herein by reference.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael A Marcheschi/
Primary Examiner, Art Unit 1793